

### REMARKS

Claims in the case are 1-6, 17-24 and 26, upon entry of this amendment. Claim 1 has been amended, and Claim 25 has been cancelled herein. Basis for the amendment to Claim 1 is found at page 2, lines 1-5 of the specification. Entry of the present amendment is respectfully requested as it is believed to place the claims in condition for allowance.

Claims 1-6 and 17-26 stand rejected under 35 U.S.C. §102(b) or in the alternative under 35 U.S.C. §103(a), Claims 1-6 and 17-26 are unpatentable over Gallagher. This rejection is respectfully traversed with regard to the amendments herein and the following remarks.

Gallagher discloses rigid vinyl chloride polymers that are reinforced by admixture with a plurality of elastomer-containing interpolymer particles (abstract). The suspension-emulsion interpolymer (SEI) of Gallagher are prepared by means of a two-stage process in which: (i) an aqueous emulsion of crosslinked elastomer particles, having a particle size of 0.1 to 0.8  $\mu\text{m}$  (column 4, lines 21-25) is first prepared as an intermediate; and (ii) then the SEI particles, having an average particle size of from 10 to 200  $\mu\text{m}$  (column 8, lines 47-52), are prepared by suspension polymerization of a monomer charge comprising vinyl chloride in the presence of the intermediate aqueous emulsion of elastomer particles (column 5, lines 59-63).

Gallagher is limited to vinyl chloride polymers, and in particular rigid vinyl chloride polymers. As such, Gallagher is not deemed to reach or touch upon Applicants' present claims, which are exclusive of vinyl chloride polymers.

Applicants wish to point out and stress that the intermediate aqueous emulsion of crosslinked elastomer particles becomes part of or is otherwise incorporated into Gallagher's final SEI particles. As such, the intermediate aqueous emulsion of crosslinked elastomer particles disclosed by Gallagher in effect substantially cease to exist as separate and/or distinct particles in the final SEI particle product.

Regarding the comments on page 4 of the Office Action of August 21, 2002, Applicants respectfully submit that Gallagher does not disclose, teach or suggest a polymer having an average latex particle size of 0.1 to 0.8  $\mu\text{m}$ , and a coarse particle Mo-6332

size of 10 to 200  $\mu\text{m}$ . Gallagher provides no disclosure or suggestion as to separately mixing the intermediate aqueous emulsion of crosslinked elastomer particles with the final SEI particle product. As discussed above, the intermediate aqueous emulsion of crosslinked elastomer particles are incorporated into Gallagher's final SEI particle product, and effectively cease to exist as separate or distinct particles.

Further, Gallagher provides no disclosure, teaching or suggestion with regard to the coarse particle size or coarse particle content of either: (i) the intermediate aqueous emulsion of crosslinked elastomer particles; or (ii) the final SEI particle product. Gallagher disclose the intermediate aqueous emulsion of crosslinked elastomer particles as having an average latex particle size of 0.1 to 0.8  $\mu\text{m}$ , and the final SEI particle product as having an average particle size of 10 to 200  $\mu\text{m}$ , and nothing more.

- In light of the preceding comments, it is respectfully submitted that Gallagher does not provide any teaching and certainly does not provide the requisite motivation that would lead a skilled artisan to alter or otherwise modify Gallagher's disclosure in the manner suggested in the Office Action.

It is respectfully submitted that the arguments in the Office Action appear to represent an instance of Examiner's assumptions being proffered as the disclosure of prior art. Examiner's assumptions do not constitute the disclosure of prior art. See In re Rijckaert, 28 U.S.P.Q.2d 1955 (CAFC 1993) wherein the Court of Appeals, Federal Circuit stated:

- In rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness ... "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art ... If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. Id. at 1956.

- Rijckaert argues that the examiner has not established a prima facie case of obviousness and that the examiner's assumptions do not constitute the disclosure of prior art. We agree. Id. at 1956.

On page 4 of the Office Action, it is argued that Gallagher either teaches or inherently encompasses polymers having course particle sizes of 20 to 500 microns. Applicants respectfully disagree. In light of the preceding remarks herein, it is clear that Gallagher provides no disclosure, teaching or suggestion with regard to the course particle size or course particle content of either: (i) the intermediate aqueous emulsion of crosslinked elastomer particles; or (ii) the final SEI particle product. Further, Gallagher does not disclose, teach or suggest separately combining the intermediate aqueous emulsion of crosslinked elastomer particles with the final SEI particle product. As such, it is not at all clear how Gallagher could inherently encompass polymers having course particle sizes of 20 to 500 microns.

What is clear is that Gallagher provides no disclosure, teaching or suggestion as to the improved physical properties of polymer compositions that include the polymer of Applicants' present claims. Attention is directed to the examples and the test results summarized in the table on page 35 of the specification in which compositions according to the present invention have significantly, and unexpectedly improved physical properties, including for example, notched impact ( $a_k$ ) and elongation at tear (DR) values.

Regarding the comments on page 4 as to inherency, "The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency.]" "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." "Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection." In re Rijckaert, 28 U.S.P.Q.2d 1955, 1957 (CAFC 1993).

It is respectfully submitted that the rejection impermissibly uses Applicants' specification as a blue print for modifying Gallagher to arrive at Applicants' invention. To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein

that which only the inventor taught is used against its teacher. In re Fine, 837 F.2d 1071, 1075 (CAFC, 1988). It is essential that "the decision-maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art". Id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Id.

Regarding the comments on pages 4 and 5 of the Office Action as to Applicants' composition claims, Applicants respectfully submit that as the polymer of their claims is not rendered anticipated or obvious by Gallagher, their claimed thermoplastic molding compositions, which include their novel, unobvious and inventive polymer, are also unanticipated and unobvious in light of Gallagher. As discussed previously herein, Gallagher does not disclose, teach or suggest the improved physical properties of the thermoplastic compositions of Applicants' present claims. Attention is directed to the examples and the test results summarized in the table on page 35 of the specification in which compositions according to the present invention have significantly, and unexpectedly improved physical properties, including for example, notched impact resistance ( $\alpha_k$ ) and elongation at tear (DR) values.

In light of the preceding remarks, Applicants' Claims are deemed to be neither anticipated nor rendered obvious by Gallagher, and as such are further deemed to be patentable over Gallagher.

In light of the amendments herein and the preceding remarks, Applicants' presently pending claims are deemed to define an invention that is unanticipated, unobvious and hence, patentable. Reconsideration of the rejections and allowance of all of the presently pending claims is respectfully requested.

Respectfully submitted,

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**VERSIONS WITH MARKINGS TO SHOW CHANGES MADE****IN THE CLAIMS:** (Marked-Up)

The following are versions of the amended claims with markings to show changes made thereto in the present Amendment.

1. (Twice Amended, Marked-Up) A polymer prepared from at least one ethylenically unsaturated monomer selected from the group consisting of [mono- or poly-unsaturated olefins] ethylene, propylene, 1,3-butadiene, isoprene, vinyl acetate, styrene,  $\alpha$ -methylstyrene, styrenes substituted at the nucleus, vinyl cyanides, maleic anhydride, N-substituted maleimides, [chloroprene,] C<sub>1</sub>-C<sub>8</sub>-alkyl acrylates and C<sub>1</sub>-C<sub>8</sub>-methacrylates,

wherein said polymer is selected from at least one of homopolymers and copolymers, has a mean particle diameter of 0.04  $\mu$ m to 1  $\mu$ m, and contains  $\leq$  100 ppm of coarse portions having a mean particle diameter of from 200 to 500  $\mu$ m.

25. (Cancelled)

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